

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Marc S. Hodes, *et al.*

Serial No.: 10/674,448

Filed: September 30, 2003

Title: METHOD AND APPARATUS FOR CONTROLLING THE FLOW
RESISTANCE OF A FLUID ON NANOSTRUCTURED OR
MICROSTRUCTURED SURFACES

Grp./A.U.: 1743

Examiner: Jyoti Nagpaul

Confirmation No.: 4121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being electronically filed
with United States Patent and trademark Office on:
March 24, 2008 (Date)

Elizabeth Schumacher
(Printed or typed name of person signing the certificate)

/Elizabeth Schumacher/
(Signature of the person signing the certificate)

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellants have carefully considered this application in connection with the Examiner's Reopening of prosecution and new grounds of rejection mailed February 22, 2008, and respectfully request a pre-appeal brief review of this application in view of the following arguments.

ARGUMENTS

Claims 1-6 and 12-13 are currently pending in the application.

I. Rejection of Claims 1 and 5-6 under 35 U.S.C. §102

The Examiner has rejected Claims 1 and 5-6 under 35 U.S.C. §102(b) as being anticipated by EP 0290125 A2 (misidentified as "WO 0290125 A2") to Humphries ("Humphries"). The Appellants submit that the Examiner has not established grounds for Humphries to teach each and every element of Claim 1.

The Examiner asserts that Humphries's rendering of walls of a microplate hydrophilic for a horizontal meniscus is equivalent to a, "means for changing the pressure of at least a first fluid disposed within said plurality of closed cells in order to cause a selected liquid to change the degree of penetration of said feature pattern," as recited in Claim 1.

The Appellants respectfully disagree that the Examiner has established that Humphries's rendering of walls of a microplate hydrophilic provides a means of changing the pressure of a fluid in the closed cell. Rather, Humphries's process for rendering his cell walls hydrophilic appears to be a static process. For instance, either Humphries's cell walls are treated e.g., by plasma etching or a surfactant treatment, or they are not treated. Therefore, there is no means for changing the pressure of a fluid, e.g., by switching back and forth between hydrophilic and hydrophobic cell walls.

Moreover, the Appellants maintain that there is no evidence that making the walls of a cell more hydrophilic, to provide a horizontal meniscus, would actually cause the pressure of a fluid within the cell to change. The Examiner has cited no portion of Humphries which discloses that

rendering walls hydrophilic, in order to provide solutions with a horizontal meniscus, will have any effect on the pressure of the solutions themselves. Nor has the Examiner explained why the changing the shape of a meniscus from non-horizontal to horizontal would inherently have any effect on the pressure of Humphries's solutions. For instance, it is not apparent to the Appellants why changing the shape of the meniscus would change the volume occupied by Humphries's solution. And, if the volume of Humphries's solution doesn't change, then how does the pressure change?

Therefore, the Appellants respectfully request the Examiner to withdraw the §102 rejection with respect to Claim 1 and its dependent claims.

II. Rejection of Claims 2-4 and 12-13 under 35 U.S.C. §103

The Examiner has also rejected Claims 2-4 and 12-13 under 35 U.S.C. §103(a) as being unpatentable over Humphries in view of U.S. Patent No. 5,459,300 to Kasman ("Kasman").

The Appellants respectfully disagree, because, for the reasons presented in Section I, Humphries does not teach or suggest all of the elements of Claim 1, which Claims 2-4 and 12-13 are dependent on.

In view of the foregoing remarks, the cited reference as applied by the Examiner does not establish a *prima facie* case of obviousness to support the Examiner's rejection of the above claim under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

III. Obviousness-Type Double Patenting Rejection of Claims 1-4

The Examiner has maintained the provisional rejection of Claims 1-4 under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Application No. 10/803,641 ('641).

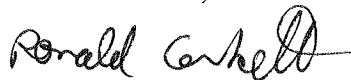
The Appellants maintain that because all the other grounds for the rejection of the claims currently pending in the application have been successfully refuted as set forth above, and because the '641 application has not yet issued, the Examiner should withdraw this provisional rejection and allow the claims to issue.

IV. Conclusion

In view of the foregoing arguments, the Appellants see all of the Claims currently pending in this application to be in condition for allowance and respectfully request the Examiner to withdraw these rejections, and issue a timely Notice of Allowance for these claims.

The Appellants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,
HITT GAINES, P.C.



Ronald J. Corbett
Registration No. 47,500

Dated: March 24, 2008
P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800